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09/378,159	08/19/1999	DAVID L. PATTON	79770F-P	8786

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/378,159

**Applicant(s)**

PATTON ET AL.

**Examiner**

Naresh Vig

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-26 and 28-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-26 and 28-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

This is in reference to the response received on 12 April 2004 to the office action mailed on 30 March 2004. There are 53 claims, i.e. claims 1 – 4, 6 – 26 and 28 – 55 pending for examination.

### ***Response to Arguments***

In response to applicant's argument that Brackney reference is merely directed to a contest where one out of many submissions may be used, and, the person submitting the image is not placing an order for a custom image product but is simply submitting an image with the hopes that it may be incorporated by the Official Postal Authority as a stamp. There is no ordering of custom official postal stamps as taught and claimed by Applicants. However, Brackney teaches that images to be incorporated in a postal stamp can be provided to the postal authority. In applicant's invention, user is providing image to the postal authority to be incorporated in a postal stamp.

In response to applicant's argument that U.S. Postal Service has not previously allowed the custom ordering of stamps with personalized images while the Stephens reference does teach use of a personal image in association with

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postal stamps, it does not teach or suggest the integrally incorporating of the image as a part of the official postal stamp. However, Stephen teaches that a postal authority has system and method available to generate personalized postal stamp with the image provided by the user. The personalized stamp can be used for postal services (image as part of official postal stamp).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4, 6 – 12, 15 – 26 and 29 – 54 are rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney and Microsoft Paint and Brasington et al. US Patent 5,923,406 hereinafter known as Brasington.

Regarding claims 1, 32, 42 and 49 – 50, USPS discloses system and for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

USPS does not disclose ordering custom postal stamp. Stephens teaches that on 19-24 March 1999 at "Australia 99" World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize

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development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user.

USPS in view of Stephens does not teach user providing an image for incorporation as an integral part of said official postal stamp. However, Stephens teaches connected (undivided) official postal stamp. Brasington teaches system and method for user providing an image for incorporation as an integral part of postal stamp (providing personalized postage stamp) [Fig. 5].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify USPS in view of Stephens as taught by Brasington to produce a postal stamp which does not break off and lose its collector item value.

Regarding claim 2, it would have been obvious to one of ordinary skill in the art at the time the invention was made that remote ordering system comprises a microprocessor having communication software to be able to communicate with USPS over the communication network.

Regarding claim 3, it is a user choice whether to use a personal computer like Windows based PCs, Apple Macintosh etc., or to use workstations like Sun, HP, IBM RS/6000 etc. to be able to communicate with USPS over the communication network.

Regarding claims 5, 33 and 43 USPS discloses to provide selections to user. USPS does not disclose to provide instructions to user. It is known to one of ordinary skill in the art at the time the invention was made to that online ordering systems provide instructions to customers on how to use the system for ordering the products to make the system to take orders without minimum human intervention (system is self sufficient) and save on personnel cost.

Regarding claim 6, USPS discloses acceptable criteria for image content of images that can be used on official postal stamp. Brackney discloses that USPS has Criteria For Stamp Subject Selection [page 2, pp 3].

Regarding claim 7, USPS discloses customers can order of plurality of images already available from USPS [page 14]. In addition, it is known to one of ordinary skill in the art at the time the invention was made that online ordering systems and method can save information to be used for future ordering. For example, One-Click ordering.

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Regarding claims 8, 38 and 48 USPS does not disclose uploading of image. Brackney, discloses that image can be uploaded in an electronic form. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to upload the information to save on cost associated with scanning the images.

Regarding claim 9 and 45, USPS does not disclose allowing customizing (modification) of prestored information by the user. However, it is known to one of ordinary skill in the art at the time the invention was made that online ordering systems and method which allows users to change the prestored information to make the system flexible to allow customers to make changes.

Regarding claim 10, USPS does not disclose computer program to have means for making changes to (customizing) information. It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to allow users to make changes to information, the system has means to allow user to provide information to the system.



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Regarding claims 11 – 12, USPS does not disclose modifying the shape, size, color, or orientation of the said image, it is obvious that when a user modifies an image, they modify the image to their desire, and, within the guidelines of the servicing business (for example, within the guidelines of the post office).

Regarding claim 15, USPS discloses postal stamps to have denominations for postal stamps. USPS does not disclose denominations for postal stamps. Stephens disclose Australia Post issuing a sheet of 10 personalized postage stamps of 45 cents each. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that postal authority issue stamps of predefined schedule to ensure that the stamps has the value as per the postal authority charge schedule.

Regarding claim 16, USPS discloses customers purchasing postal products from USPS with the denominations printed on the postal stamps. It would have been obvious to one of ordinary skill in the art at the time the invention was made that USPS modifies denominations on postal products when the denomination schedule changes to ensure that it is charging the correct postage to consumers.

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Regarding claims 17 and 34, USPS discloses that customers can purchase postal stamps online [page 14]. USPS does not disclose providing electronic order form. It would have been obvious to one of ordinary skill in the art at the time invention made that online shopping systems provide an electronic order form for completion at customer's ordering system and transmitting the completed form to vendors computer system to gather the information from the user. For example, online shopping at Amazon.com.

Regarding claim 18, USPS does not disclose providing notification. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to provide notification to user to inform the user that the transaction has been accepted.

Regarding claim 19 USPS does not discloses order form to include means for providing payment. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to provide means to allow customer to provide payment information to allow customer to make payment at the time of purchase and minimize cost of billing the customer.

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Regarding claims 20 – 21, USPS does not disclose order form and its contents. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to that order forms are known to include contact information like customer information, phone number, address, e-mail address.

Regarding claims 22 and 35 and 44 USPS does not disclose creating a receipt of order form. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to create receipt from transactions to inform the customer of what they have ordered, what the charges are, and complete the order.

Regarding claims 23 and 36 and 46 it is a design choice to elect what the content of the receipt should look like. For example, confirmation receipt from fax machines, some receipts include image of first page of the fax sent.

Regarding claim 24, USPS does not disclose notifying customer about status of their order. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to notify customer the status of their order to keep the customer informed about their order.

Regarding claim 25, USPS does not disclose order identification number. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to have order identification number to differentiate between orders.

Regarding claim 26, USPS does not disclose printing device. It would have been obvious to one of ordinary skill in the art at the time invention was made that USPS has printing device to print the postal stamps. Also, it would have been obvious to one of ordinary skill in the art at the time invention was made that at Australia 99, Australia Post had printed device to print the personalized postal stamps.

Regarding claims 29 – 30, USPS does not disclose means for manipulation of image. Brackney discloses that contents of a stamp can be generated and submitted in electronic form. A user can use tool like Microsoft Paint to generate an image, manipulate image etc., and transfer the updated image in an electronic form to the supplier like USPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have means for manipulation of image to avoid cost associated with scanning of modified images.

Regarding claims 30 and 51, it would have been obvious to one of ordinary skill in the art at the time invention was made that Microsoft Paint (available with Windows 95) has selection button for incrementally moving the image a predetermined incremental amount in at least one direction.

Regarding claim 31, it is a design choice to elect how large an image can be enlarged.

Regarding claims 37 and 47, USPS does not disclose reviewing image at remote computer system prior to uploading image to said central authorizing computer system. USPS discloses to have guidelines for images on postal stamps. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to review the image prior to submitting image to USPS to ensure that the image will be approved for imprinting on the postage stamp.

Regarding claim 39, USPS discloses to have guidelines for images on postal stamps. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain approval for image to be printed on the postal

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stamp to ensure that the image has met the USPS guidelines for imprinting on the postage stamp.

Regarding claim 40, USPS discloses printing of postage stamp. Also, Stephens teaches that at Australia 99 World Stamp Expo, Australia Post teaches to print approved (stamp images meeting guidelines) personalized postage stamp.

Regarding claim 41, USPS does not disclose allowing users to check status of order. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to allow users to check status of order placed online to make the system self sufficient, save on personnel cost associated with supporting customer calling in to check order status etc.

Regarding claims 55, USPS discloses system and for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

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USPS does not disclose ordering custom postal stamp. Stephens teaches that on 19-24 March 1999 at "Australia 99" World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user. USPS discloses allowing users to order stamps with prestored images [page 14].

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Claims 13 – 14 are rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney, Microsoft Paint, Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and Kara US Patent 5,819,240.

Regarding claims 13 – 14, USPS discloses text on postal stamps. USPS does not disclose providing text for prestored images. Kara teaches to provide a menu of postage indicia that can be selected by the customer for particular occasions. The user is able to create or select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can also personalize postage indicia. In addition, the user is provided with a message box to allow the user to add an optional message or greeting (e.g., "Happy Holidays") to be printed next to the meter stamp. This message may be changed at any time by the user, directly or by a "merge" command in conjunction with a word processing or graphics program coupled to the E-STAMP program. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to print personalized message.



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Claim 28 is rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney, Microsoft Paint and Brasington et al. US Patent 5,923,406 hereinafter known as Brasington.

Regarding claim 28, USPS does not disclose portion of the custom image is combined with a prestored image. Brasington discloses personalized postage stamp including predetermined data required by postal authority [abstract]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine custom image with predetermined data to ensure that the stamp has the date required by postal authority.

Claim 55 is rejected under 35 USC 103(a) as being unpatentable over United States Postal Service hereinafter known as USPS in view of an article by Glen Stephens teaching personalized postage stamps at Australia 99 World Stamps Expo hereinafter known as Stephens, and further in view of an article by Marilyn J. Brackney hereinafter known as Brackney, Microsoft Paint, Brasington et al. US Patent 5,923,406 hereinafter known as Brasington and Mold US Patent 5,9978,772.

Regarding claims 52 – 54, USPS discloses system and for ordering a Official Postal Stamp. USPS discloses a central authorizing computer system for communicating with remote ordering system over a communication network, it is obvious that USPS computer system has a computer program for allowing customers to order Official Postal Stamp.

USPS does not disclose ordering custom postal stamp. Stephens teaches that on 19-24 March 1999 at “Australia 99” World Stamp Expo, audience could purchase a sheet of 10 stamps of personalized postage stamps. Neither USPS nor Stephens discloses allowing customers to forward image to the issuing authority. Brackney teaches system and method to design a postage stamp for Black History Month (image provided for the stamp). Brackney discloses that image can be transferred in electronic form [page 2, email the image]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow customers to order personalized postage stamps from USPS.

It would have been obvious to one of ordinary skill in the art at the time invention was made that the users are known to use personal computers with Microsoft Windows for communicating with vendor computers for placing orders over the internet. Microsoft Paint is a tool available with Microsoft Windows operating system which a user can use for generating and manipulating images. It is known at the time of invention to a person with ordinary skill in the art the tools available by Microsoft operating system can be used by the product developer to reuse the tool readily available and minimize

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development costs. For example, calculator tool which comes with Microsoft Windows is used for providing calculator interface to the user.

USPS does not disclose means for manipulation of image. Brackney discloses that contents of a stamp can be generated and submitted in electronic form. Official notice it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that a user can use tool like Microsoft Paint (commercially available at the time the invention was made) to generate an image, manipulate image etc., and transfer the updated image in an electronic form to the supplier like USPS. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have means for manipulation of image to avoid cost associated with scanning of modified images.

USPS does not disclose creating a receipt of order form. However, it would have been obvious to one of ordinary skill in the art at the time invention was made to create receipt from transactions to inform the customer of what they have ordered, what the charges are, and complete the order.

USPS does not discloses printing barcode on the receipt. However, Mold teaches a receipt with the barcode printed on a receipt. Therefore, it is known at the time of invention to a person with ordinary skill in the art to print barcode on the receipt to expedite the sales process by minimizing the customer service representative or the customer to manually enter the order number for checking the status, picking up the order etc.

USPS does not disclose barcode reader. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a barcode reader should the business decide to implement barcode identification to be able to read the barcode and minimize keyboard entry.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Gravel et al. International Publication Number WO 98/57303
2. Mug Shot Stamps From Australia Post!

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.



Naresh Vig  
Patent Examiner  
October 14, 2004